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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,900

06/14/2005

Scott Thomas Milner

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6056

23455 7590 05/13/2008  
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EXAMINER

RABAGO, ROBERTO

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,900	<b>Applicant(s)</b> MILNER ET AL.	
	<b>Examiner</b> Roberto Rábago	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-18,20-51,53 and 59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-18,20-51,53 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Prior rejection over Halasa '988 is withdrawn in view of amendment to claim 1 which now requires at least 15 volume % HFC; the reference discloses HFC amounts only up to about 10%.

2. The terminal disclaimer filed on 10/10/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 7,232,872 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Double Patenting***

3. Claims 1-7, 9-18, 20-32, 34-38, 42-51, 53 and 59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 10/539,013. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are anticipated by the copending claims.

Applicant's arguments filed 1/17/2007 have been fully considered but they are not persuasive. Applicants argue that in view of amendments made in this application, the instant claims are no longer broader than the copending claims as stated in the original rejection. It is true that the additional limitations have been added to the independent claims of this application; however, missing from applicants' remarks is any

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clear basis to conclude that the instant claims are not still anticipated by the copending claims. In fact, all of the features which have been added to the independent claims of this application are also recited in the dependent claims of the copending application. For example, see copending claims 6 and 30-42 for Lewis acids; see copending claims 24-26 for HFC percentages; see claims 56-60 for temperatures and pressures. While the two applications differ in how features of the dependent claims have been re-shuffled, the instant claims are anticipated because essentially the same process has been claimed in each application. The primary difference between the two is that the copending claims include an additional step of evaporating the diluent during polymerization; however, the instant claims are open-ended, and therefore are broader than the copending claims regarding evaporation. Regarding claims 42-46, the copending claims do not recite the diluent uptake; however, in view of the substantially identical processes and products described in each specification, the claimed value would appear to inherently occur merely as a result of operating the process of the copending claims; the burden of proof is shifted to applicants to show otherwise. Regarding claim 38, all of the HFC's recited in the copending claims have the required dielectric constant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 33 and 39-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of

copending Application No. 10/539,013. The parent claims are discussed with respect to this reference above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are obvious over the copending claims.

Regarding claim 33, one of ordinary skill in the art would be motivated to substantially eliminate water because water is not recited in any copending claims other than 47 and 51. Furthermore, water typically has a deleterious effect in olefin polymerizations, as is commonly known in the art, and therefore the ordinary skilled worker would be motivated to substantially eliminate water from the process. Regarding claims 39-41, one of ordinary skill in the art would be motivated to select a diluent with the required dielectric constant because copending claim 22 recites numerous species which appear to have the required dielectric constant.

### ***Claim Rejections - 35 USC § 112***

5. Claim 53 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is directed to a polymerization medium; however, in line 7, the word "medium" has not been included after "polymerization", and therefore it cannot be determined whether the temperature and pressure limitations apply to the claimed medium, or are simply intended-use limitations directed to a potential process. The claim has been previously examined using the interpretation that the stated temperature

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and pressure apply to the medium; however, upon further consideration, the intended status of these limitations cannot be clearly determined from the wording of the claim.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/  
Primary Examiner  
Art Unit 1796

RR  
May 9, 2008